

REMARKS

By this Office Action, the Examiner has required restriction to one of the following inventions under 35 U.S.C. §121:

- I. Claims 1-10 and 12-14, drawn to polynucleotides, host cells, and recombinant methods of protein production, classified in at least class 435, subclass 69.1, for example.
- II. Claim 11, drawn to probes and/or primers, classified in class 536, subclass 24.3, for example.
- III. Claims 15-20 and 44-45, drawn to polypeptides and pharmaceutical compositions, classified in class 530, subclass 350, for example.
- IV. Claims 21-29 and 41, drawn to antibodies and claims 49-50 in so far as they encompass antibodies, classified in class 530, subclass 387.1, for example.
- V. Claims 30-36, drawn to a method of detecting protein in a sample using an antibody, classified in class 436, subclass 501, for example.
- VI. Claims 37-40, drawn to a method of detecting disease by measuring protein, classified in class 436, subclass 501, for example.
- VII. Claims 42-43, drawn to a method for changing body weight by inhibiting protein expression, classified in class 514, subclass 2, for example.
- VIII. Claims 46-47, drawn to a method of reducing body weight by administration of protein, classified in class 514, subclass 2, for example.
- IX. Claim 48, drawn to a method of reducing body weight by administration of nucleic acid, classified in class 514, subclass 44, for example.
- X. Claims 49-50, drawn to an antagonistic compound, classified in class undetermined, subclass undetermined.

- XI. Claim 51, drawn to a method of increasing body weight by administration of an antagonistic compound, classified in class undetermined, subclass undetermined.

Responsive to the Requirement for Restriction, Applicants elect to prosecute the invention of Group V, with traverse, claims 30-36, which are drawn to a method of detecting protein in a sample using an antibody, classified in class 436, subclass 501, for example.

Applicants respectfully request reconsideration of the Requirement for Restriction, or in the alternative, modification of the Restriction Requirement to allow prosecution of more than one group of Claims designated by the Examiner in the present Application, for the reasons provided as follows.

Under 35 U.S.C. §121 "two or more independent and distinct inventions ... in one Application may ... be restricted to one of the inventions." Inventions are "independent" if "there is no disclosed relationship between the two or more subjects disclosed" (MPEP 802.01). The term "distinct" means that "two or more subjects as disclosed are related ... but are capable of separate manufacture, use or sale as claimed, AND ARE PATENTABLE OVER EACH OTHER" (MPEP 802.01) (emphasis in original). However, even with patentably distinct inventions, restriction is not required unless one of the following reasons appear (MPEP 808.02):

1. Separate classification
2. Separate status in the art; or
3. Different field of search.

Further, under Patent Office Examining Procedures, "[i]f the Search and Examination of an entire Application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions" (MPEP 803, Rev. 8, May 1988) (emphasis added).

Applicants respectfully submit that the groups designated by the Examiner fail to define compositions and methods, with properties so distinct as to warrant separate Examination and

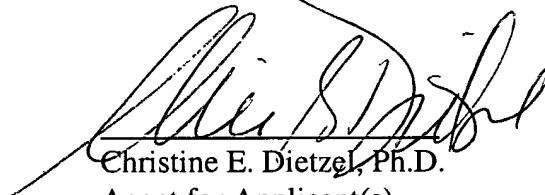
Search. In particular, claims 37-40 of Group VI are drawn to a method of detecting disease by measuring proteins, and the method of claims 37-40 is fundamentally related to claims 30-36 of Group V, drawn to a method of detecting protein in a sample using an antibody. In fact, claims 37-40 depend from claim 36, which depends from claim 30. Thus the invention and methods of Group VI depend from the invention and methods of Group V. The claims of Group V relate to a method for measuring the presence of an OB polypeptide in a sample (claims 30-35), or for evaluating the level of OB polypeptide in a sample (claim 36), by contacting sample with an antibody that binds to the OB polypeptide and detecting and evaluating the reaction complex. Claims 37-40 of Group VI relate to a method for detecting or diagnosing the presence of a disease (claim 37), or for monitoring therapeutic treatment of a disease (claims 38-40), associated with elevated or decreased levels of OB polypeptide according to the method of claim 36. The methods, therefore, use overlapping steps and have similar modes of operation, detecting or measuring OB protein utilizing an antibody that binds to the OB polypeptide. The search for any of the methods separately classified by the Examiner as the invention of Group VI would require an additional search of the identical classes wherein the V are classified, thus resulting in a duplicate search for the same material. Thus, Applicants submit that the Search and Examination of the entire Application, or, at least, of Group VI with Group V can be made without serious burden, and therefore the Examiner must examine all of the claims of the Application on the merits.

The Examiner's assertions to the contrary notwithstanding, Applicants respectfully submit that conjoint examination and inclusion of all of the Claims of the present Application would not present an undue burden on the Examiner, and accordingly, withdrawal of the Requirement for Restriction, or, at the least, modification to include the Claims drawn to Group V and Group VI is in order.

No fees are believed to be necessitated by the foregoing Response. However, should this be erroneous, authorization is hereby given to charge Deposit Account No. 11-1153 for any underpayment, or credit any overages.

In view of the above, withdrawal of the Requirement for the Restriction is requested, and an early action on the merits of the Claims is courteously solicited.

Respectfully submitted,



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